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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/798,940

03/11/2004

Martin Letz

4965-000178

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EXAMINER

KOSLOW, CAROL M

ART UNIT

PAPER NUMBER

1755

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/798,940	Applicant(s) LETZ ET AL.	
	Examiner C. Melissa Koslow	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-17, 23-36 and 45-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 and 36 is/are allowed.
- 6) ☒ Claim(s) 14-17, 23-34 and 45-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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This action is in response to applicants' amendment of 28 December 2006. The amendments to the claims have overcome the rejections over canceled claims 1-13, the art rejections, the 35 USC 101 rejection over claims 23-29 and 33, the obviousness-type double rejection over claims 23 and 25-29 and the objection to claim 14. The amendments to the specification have overcome the objection to the disclosure with the exception to the amount of trivalent rare earth cations and the total amount of ZnO, alkali earth oxides and alkaline earth oxides in claims 14, 16 and 17 and the 35 USC 112, first paragraph rejection. The amendments to the claims and the specification have overcome the objection to the specification as failing to provide proper antecedent basis for the claimed subject matter. Applicant's arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

The indicated allowability of claims 16 and 17 are withdrawn upon reconsideration of what is taught in the claims of copending application 11/116,044.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The amount of trivalent rare earth cations of exceeding 1 mol% and the total amount of ZnO, alkali earth oxides and alkaline earth oxides of 0-50 mol% in claims 14, 16 and 17.

The amendments did not overcome these objections.

Claims 15, 17, 24 and 53-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 15 and 17 are duplicate claims since they cover the same subject matter.

Applicant is advised that should claim 17 be found allowable, claim 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 14 teaches the base glass is phosphate glass, but claim 24, which ultimately depends from claim 14, teaches the base glass is a silicate glass, a flint glass, a sod-lime glass, a lanthanum oxide borate glass, a chalcogenide glass or a halide glass, none of which are phosphate glasses. Thus this claim is indefinite.

Claim 24 lists a lanthanum oxide borate glass as a base glass of claim 23 which contains at most 1 wt% boron oxide, but lanthanum oxide borate glasses contain more than 1 wt% boron oxide, as shown by U.S. patent 3,254,031. Thus claim 24 includes a glass excluded from claim 23 and thus is indefinite.

Finally, claims 53-55 are indefinite since these claims do not require  $\text{RE}_2\text{O}_3$  to include the required terbium, europium oxides and thulium of claim 14. The wording of these claims teaches  $\text{RE}_2\text{O}_3$  is at least two of all the listed oxides.

Applicants arguments with respect to the previous 35 USC 112 rejection is not convincing since a glass containing 1 wt% or less boron oxide would not be considered a borate glass by the art. Therefore lanthanum borate glasses are excluded from the glasses of claim 23. The rejection is maintained.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and

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useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 30-32 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 15-17 of copending Application No. 11/116,044. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Applicants argue claims 30-32 depend from claim 14. This is incorrect. Claim 30 is an independent claim and claims 31 and 32 depend from it. The rejection is maintained.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claim 33 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-17 of copending Application No. 11/116,044.

Although the conflicting claims are not identical, they are not patentably distinct from each other because glass compositions conventionally contains less than 0.1 wt% water and thus one would expect the glass of claims 15-17 to have an amount of water that falls within the claimed range, absent any showing thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 14-17, 23, 25-29 and 45-55 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 11/116,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because the glass compositions claims in both applicants overlap each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 34 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 7, 10 and 15-19 of copending Application No. 11/236,756. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed glass compositions overlap each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The terminal disclaimer filed on 28 December 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of applications 11/116044 and 11/236756 has been reviewed and is NOT accepted.

The disclaimer cites the instant case as a copending application which is being terminally disclaimed.

Since the terminal disclaimer is not acceptable, the rejections are maintained.

Claims 35 and 36 are allowable over the cited art of record.

These claims are allowable for the reasons given in the previous action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

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The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk  
February 9, 2007

  
C. Melissa Koslow  
Primary Examiner  
Tech. Center 1700